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CHARLES ELMORE CROPLEY

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 397

GENERAL PORCELAIN ENAMELING AND MANUFACTURING COMPANY,

Petitioner,

vs.

THE CERAMIC PROCESS COMPANY,

Respondent.

PETITION OF GENERAL PORCELAIN ENAMELING AND MANUFACTURING COMPANY, FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

MAX W. ZABEL,
Counsel for Petitioner.

THE BLAKEMORE-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, General Porcelain Enameling and Manufacturing Company, respectfully prays the grant of the Writ of Certiorari to the Circuit Court of Appeals for the Seventh Circuit to review the judgment of that Court entered July 16, 1942. A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the rules of this Court.

Summary and Short Statement.

(1) The Ceramic Process Company, respondent, filed its Bill of Complaint in the United States District Court for the Northern District of Illinois, Eastern Division, against General Porcelain Enameling and Manufacturing Company, petitioner, to enjoin infringement of United States Reissue Letters Patent No. 16,048, reissued on April 21, 1925. The original patent application was filed in the names of Herbert Hamilton Scott and George McIntosh Scott on March 26, 1923 and the original patent was issued on November 18, 1924 as patent No. 1,516,065. The application for reissue was filed March 12, 1925. The present owner of the patent is the respondent, The Ceramic Process Company.

(2) The said District Court on August 22, 1941 (R. p. 165) filed an opinion in very general language and erroneously referred to a "defendant's patent." The findings of fact (R. p. 165) and conclusions of law (R. p. 167) are couched only in general language, as no specific findings could properly be based on the opinion rendered by the Court, and there is no fact finding at all in connection with the controlling feature of this case. The Court found the reissue patent and its three claims valid and infringed. The interlocutory decree drawn in accordance with the opinion is found on page 168. Thereupon appeal was taken by petitioner to the Circuit Court of Appeals for the Seventh Circuit and said Circuit Court of Appeals by an opinion handed down July 16, 1942 affirmed the decree of the District Court. The opinion of the Circuit Court of Appeals is found on page 206 of the record. A petition for rehearing was thereupon filed and said petition for rehearing was denied on August 17, 1942 (R. p. 239). Within a few days it was ordered that the mandate be stayed provided petitioner filed its petition for cer-

tiorari promptly and if so that the mandate would be further stayed until final action on this petition.

(3) All of the three claims of the patent which were in controversy before the District Court and the Circuit Court of Appeals are involved in this petition.

(4) THIS PETITION PRESENTS AS PROPOSITIONS OF LAW, (a) the invalidity of the reissue patent based upon this Honorable Court's decision in *U. S. Industrial Chemicals, Inc.* v. *Carbide & Carbon Chemicals Corporation,* decided March 30, 1942 (No. 680) 315 U. S. 668; (b) the non-infringing nature of the accused process in accordance with the decision of this Honorable Court in *Schriber-Schroth* v. *Cleveland,* 311 U. S. 211, 85 L. Ed. 132; (c) the nature of the contractual relationships existing between practically all of the industry (R. p. 61, Folio 110) with respect to this patent are inequitable along such fundamental lines as should deny respondent the right of access to the Courts in behalf of said patent, the effect of such relations not having been passed upon by this Honorable Court and, (d) the reissue patent is invalid on the Patent Office record as a matter of law.

(5) The decision of the Circuit Court of Appeals for the Seventh Circuit in validating this patent is in direct conflict with the above mentioned decisions of this Honorable Court.

Patent in Suit.

The patent in suit expired on November 17, 1941 but the contractual relationships in connection therewith still subsist. The three claims of the patent are directed to a certain method or process (apparatus claims which had been originally presented to the Patent Office having been rejected and their rejection acquiesced in). The patented process is for the purpose of applying to an enamel surface a superposed enamel surface representing a legend

or design. In carrying out the process the patent uses the prior art mesh stencil (Fig. 8, R. p. 192), which mesh stencil is placed upon the original enamel surface and through which mesh stencil an enamel composition is overlaid on said original enamel surface, whereupon the mesh stencil is removed and the article fired a second time to transform the deposited composition into a fired enamel surface. A fired enamel is the same as glass (R. p. 119). The mesh stencil (Fig. 8, R. p. 192) is blocked out, except for the legend or picture, by paper pasted thereon, so that the enamel composition which is applied to the underlying enamel through the exposed mesh is in the form of said legend or picture. We have added as "Appendix A" a reproduced copy of the reissue patent in suit, in which those portions not underscored show the application as originally filed, in which those portions which are underscored by a straight line were added by an amendment which was made to the application after its final rejection and prior to the allowance of the claims which were incorporated in the original patent (R. p. 188), and in which those portions which are underlined by a wavy line indicate those portions which were added in the reissue application. The reissue application was filed in order to narrow the claims (R. p. 161), admitting at the same time that the claims of the original patent were too broad.

The Dissimilarity Between the Alleged Invention Originally Claimed and the Alleged Invention Claimed in the Reissue.

The originally alleged invention (please see Appendix A or R. p. 182) consisted in the provision of a mixture "composed of one part by volume of turpentine, 1 part by volume of beeswax, and 8 parts by volume of paraffin oil * * * mixed with approximately three times

its weight of the quartz-like enamel or 'enamel frit' and oxide mixture and the whole is ground in a mill after which a small proportion of a varnish such as lithovarnish amounting for example to one to two per cent of the aforesaid oily mixture is well mixed in." The so-called "enamel frit" consists of finely ground quartz-like enamel and an oxide mixture which, when heated to around 1500° F. will fuse into glass and present an enamel surface. This mixture is applied through the mesh stencil to the underlying enamel surface and fired. This mixture (R. p. 182 and Appendix A) is described as a "pasty composition" in the originally filed patent application.

The claims as originally filed (R. pp. 135 to 137), including a claim 4 specifically defining the enamel mixture, were finally rejected (R. p. 142). Thereupon new matter (R. pp. 143, 144, 145) as underlined by straight lines in Appendix A was added which entirely changed the nature of the invention but which secured the allowance of the claims of the original patent as found on pages 145 to 147 of the record. In making that addition the applicant stated (R. p. 148):

> "The paste or composition after being forced through the stencil mesh is deposited on the enamel base in a finely divided condition. This finely divided condition of the paste is necessary in order that during the firing of the product the volatile materials in the paste be driven off before a fusing temperature be reached for fusing the remaining vitreous enamel material."

The original underlying application was silent on that point. It was on the basis of that change that the claims were allowed in the original patent. This alone was improper, because the claims as issued in the original patent were for a different invention than that found in the underlying original specification.

Nevertheless, respondent found within a year from the

time that the original patent issued that the claims were still too broad, and in drawing the reissue added all of the material underlined by wavy lines in Appendix A. This additional matter is directed solely to further defining the flow characteristics of what was originally called a "paste", to a point where it would have to be a material *which will not "run" together.* The reissue patent (R. p. 184 or Appendix A) states, beginning at the bottom of the left-hand column—

> "We further found, however, that if the vitreous enamel composition with oily medium was mixed to a pasty consistency and passed through the mesh, the paste would be applied to the surface in small separated particles as stated, which will not 'run' together, thus enabling the volatile matter to pass off freely without blistering the enamel."

The reissue for the first time defined the consistency of the "paste" to be of such a nature that the material when deposited will not run together, thereby incorporating therein an invention (if such it was), which is not found in the original patent. The whole invention herein is based upon the degree of fluidity of a "paste", undefined in the originally filed patent application, somewhat defined by amendment before allowance of any claim in the original patent, and entirely differently defined and qualified in the reissue. The *only* evidence in the record as to the consistency or fluidity of the material used by the defendant is to the effect that the deposited material runs together the instant that it is being deposited upon the underlying enamel surface (R. p. 57). This is because petitioner uses a material of paint-like consistency such as used in the Beck prior art patent (R. p. 192). The only evidence of the character of petitioner's material put into the record by plaintiff is the answer by petitioner to respondent's interrogatory as appearing upon page 4 of the record; and which says nothing at all concerning the fluidity of the material which is used by the defendant. This interroga-

tory defines a process which is the equivalent of the claims that were rejected and cancelled.

We respectfully submit that the Court of Appeals erred in not construing the qualification made by respondent in its patent application and its application for reissue strictly against respondent as required by this Court in accordance with the decision in *Schriber-Schroth* v. *Cleveland, supra,* thus absolving petitioner of the charge of infringement.

We further respectfully submit that the decision of the Circuit Court of Appeals is also in conflict with the decision of this Honorable Court in *United States Industrial Chemicals* v. *Carbide & Carbon Chemicals, supra,* because the invention (if any) of the reissue patent is not the same as that of the original patent.

We wish further to call to the attention of this Court that the illustration appearing on page 111 of the record is not a correct illustration. This was prepared by respondent for use in another suit (R. p. 33). In defendant's process the screen at no time touches the sign (R. p. 57). This is for the reason that a surrounding edge of paper underlies the screen and thus keeps it away from the underlying enamel surface. Petitioner's material of paint-like consistency flows readily through and around the meshes of the screen and is continuous even before the material reaches the underlying enamel surface.

After removal of the screen petitioner's deposited material shows mesh marks throughout a portion of its surface which are akin to slight paint brush marks (R. pp. 54 and 59), the remaining portions of the surface being continuous. Nowhere is there found an undulatory surface such as shown in Fig. 3 (R. p. 111). Yet respondent disclaims a flowing together such as shown in Fig. 3 (R. p. 34) as being in accordance with the patented procees, characterizing the condition of the material in Fig. 3 as "leveling itself completely."

The Contractual Relationships With Respect to Licensing By Respondent.

The patent in suit is owned by respondent (R. p. 14) and the reason for its acquisition is set forth on page 20 of the record. Its relationship to Solar Laboratories, a patent holding corporation, is set forth on page 61 of the record. The license agreements are set forth on pages 113, 114, 115, 116, 118, 119, 120, 121 and 123. The number of patents involved in these license agreements is set forth on pages 117, 118 and 122. The list of licensees is set forth on pages 124 to 129 inclusive. As stated in the record (p. 61, folio 110) substantially the entire industry is licensed. The great number of patents involved in these agreements is thus apparent. In referring to page 117 of the record we find that the patents involved in these license agreements date back to as early as February 6, 1923. On page 124 they are shown to date back to December 9, 1924. The earlier patents including the Scott patent in suit have expired, yet they are still used contractually to bind an industry by the use of machinery which respondent may purchase on its own account, yet which machinery is limited in its use to certain qualifications and the use of which machinery in connection with expired patents still requires the payment of license fees. Under a condition such as this the effective value of the patent does not even expire when the patent term is over. Such use of a patent certainly is not contemplated either by the constitution or the laws enacted thereunder.

It is our respectful contention that contractual relationships so drawn as to create a monopoly which continues after the expiration date of the patent on which they are based are inequitable to such a degree as to destroy the right to a recovery under any patent used in such manner.

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Questions Presented.

The questions presented to this Honorable Court are therefore: (a) can qualifying statements made by an applicant in order to secure allowance of a patent be disregarded; (b) is a reissue valid for an invention not disclosed in the original; (c) is it proper to enter into contractual relationships which extend the monopoly period of a patent beyond seventeen years; and (d) do the patent laws contemplate that the provision of a process using the same steps as the process of a prior art patent (R. p. 192) and in which the only change is in the use of a material having a different mixture of less fluidity, constitute invention.

Reasons Relied on For Granting the Writ.

(1) The decision of the Circuit Court of Appeals for the Seventh Circuit is in direct conflict with the following decisions by this Honorable Court:

U. S. Industrial Chemicals, Inc. v. *Carbide & Carbon Chemicals Corporation,* 315 U. S. 668.

Schriber-Schroth v. *Cleveland,* 311 U. S. 211; 85 L. Ed. 132.

Morton Salt Company v. The G. S. Suppiger Company, 314 U. S. 488..... 8, 9

(2) Contractual relationships so drawn as to continue a patent monopoly beyond the expiration date of the patent deny the patent owner the right to rely on such patent for any recovery.

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Circuit Court of Appeals for the Seventh Circuit, commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and

complete transcript of the record and all proceedings in the case numbered and entitled on its docket No. 7860, The Ceramic Process Company, Plaintiff-Appellee *vs.* General Porcelain Enameling and Manufacturing Company, Defendant-Appellant, and that the said decree of the Circuit Court of Appeals for the Seventh Circuit may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

MAX W. ZABEL,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION.

Jurisdiction.

Petitioner would invoke the jurisdiction of this Court under Sec. 240 (a) of the Judicial Code as amended by Act of February 13, 1925, U. S. C., Title 28, Sec. 347, to review the decree of the U. S. Circuit Court of Appeals for the Seventh Circuit entered July 16, 1942 (petition for rehearing submitted by leave of Court denied August 17, 1942) (R. p. 239) affirming the decree of the District Court (Northern District of Illinois, Eastern Division) (R. p. 168) which held the Scott Reissue Patent to be valid and infringed. This petition is presented within the time allowed by statute.

Statement.

The foregoing petition contains a summary of the material facts. The petition also sets forth the reasons relied on for the allowance of the writ, as well as a statement of the questions involved.

Specifications of Errors.

The Circuit Court of Appeals for the Seventh Circuit erred:

(1) In failing to decree that the reissue claims in suit are invalid because they are for an invention other than the invention claimed in the original patent.

(2) In failing to construe the claims in accordance with definite limitations made therein by the applicants for the patent.

(3) In failing to decree that the petitioner's device does not infringe the claims of the reissue patent in suit.

(4) In failing to decree that respondent was not entitled to a favorable decree during the continuance of the contractual relationships which it had with substantially the entire industry.

(5) In ordering the entry of a decree granting respondent an accounting.

(6) In failing to award costs to petitioner.

Argument.

We feel that the facts set forth in the petition are of such a nature that further argument is unnecessary. We wish, however, to add that the original specification while referring to "paste," did not define anything in connection with that paste as to its fluidity. It was only after final rejection that an amendment was made qualifying the word paste so as to define it as of such a consistency that when the particles were deposited upon the underlying enamel surface the particles would remain separated so that the volatile materials could be driven off during firing. That alone, in our judgment, made a finding of non-infringement necessary; yet the reissue further qualified the meaning of the word "paste" by definitely stating that the particles when deposited must not "run" together,—renounced the claims of the original patent, and inserted claims based upon that definition. It is obvious that the decision of the Circuit Court of Appeals (the only evidence being to the effect that petitioner's material instantly runs together) disregarded what was said by this Court in Schriber-Schroth, *supra.*

If the patent here in suit is supposed to be the fundamental patent which respondent contends for, in that it

controls an industry, then contractual relationships which do not take account of its expiration date render recourse to the Courts under such patent inequitable.

Respectfully,

MAX W. ZABEL,
Counsel for Petitioner.

STATE OF ILLINOIS, }
COUNTY OF COOK. } ss:

MAX W. ZABEL, being duly sworn, deposes and says that this Petition for a Writ of Certiorari is presented in good faith, that he believes it to be sound in law and in fact, and that it is not presented for the purposes of delay.

.....

Subscribed and sworn to before me this ..... day of September, 1942.

.....
Notary Public.

My commission expires .....

APPENDIX A

Reissued Apr. 21, 1925. Re. 16,048

UNITED STATES PATENT OFFICE.

HERBERT HAMILTON SCOTT AND GEORGE McINTOSH SCOTT, OF LONDON, ENGLAND.

PRODUCTION OF SHOW CARDS, ADVERTISEMENTS, SIGNS, DECORATIONS, OR THE LIKE BY STENCILING.

No Drawing. Original No. 1,516,065, dated November 18, 1924, Serial No. 627,932, filed March 26, 1923. Application for reissue filed March 12, 1925. Serial No. 15,122.

To all whom it may concern:

Be it known that HERBERT HAMILTON SCOTT and GEORGE McINTOSH SCOTT, subjects of the King of Great Britain, residing at 45 Kingsway, London, W. C. 2, England, have invented certain new and useful Improvements Relating to the Production of Show Cards, Advertisements, Signs, Decorations, or the like by Stenciling, of which the following is a specification.

This invention relates to the production of showcards, advertisements, signs, decorations or other decorative articles by stenciling, the chief object being to enable vitreous enamel metal signs and the like to be manufactured commercially in large numbers in a rapid, inexpensive and simple manner.

Hitherto the commercial production of vitreous enamel metal signs, particularly signs with complicated or multi-colored designs or lettering thereon, has been limited owing to the many operations and great labor and expense involved in the method of production hitherto employed. The drawback and limitations to printing methods with the aid of a litho-stone or zinc plate, the aerographing method, and the "brushing out" method are well known in the trade.

According to the present invention vitreous enamel metal signs or other decorative articles are produced by preparing a vitreous enameling composition or paint of suitable consistency and drying characteristics, applying the composition to a vitreous surface to be decorated by means of a screen or stencil of silk or other meshed material having permeable and impermeable portions, and finally heating the article so treated to a temperature sufficient to cause fusion of the vitreous composition. In the preparation of the paint or composition finely ground quartz-like enamel or "enamel frit" is used as the body or base which is colored as required by means of the powdered enameling oxides of commerce and worked up to a suitable consistency to pass through the meshes of the stencil employed.

The fineness of the powdered materials should be as great as is necessary to enable the composition to pass through the meshes of the stencil and the materials should therefore be capable in their dry unmixed state of passing through a screen of slightly finer mesh. We have found that a fineness of powder corresponding to two hundred meshes to the square inch gives satisfactory results. The stencil used with such powder would have about 130 to 140 meshes to the square inch, but the fineness of powder used depends to some extent on the amount of detail to be shown on the metal sign.

In working up the powdered quartz-like enamel or "enamel frit" and oxide mixture into a suitable pasty mass a liquid must be used that will not permit of too rapid drying and yet can eventually be dried completely without causing the surface to be spoilt by bubbles or otherwise when the article is subjected to the "enamel fusing" temperature. We have found that liquid of an oily character should be used. For example we have found that a mixture composed of one part by volume of turpentine, 1 part by volume of beeswax, and 8 parts by volume of paraffin oil gives excellent results. This oily mixture is taken and mixed with approximately three times its weight of the quartz-like enamel or "enamel frit" and oxide mixture and the whole is ground in a mill after which a small proportion of a varnish such as lithovarnish amounting for example to one to two per cent of the aforesaid oily mixture is well mixed in. The proportion of the colored oxide to quartz-like enamel or frit depends on the quality and nature of the oxide and generally speaking varies from 4 to 20 per cent. The pasty composition is effectively and simply applied by pressing it through the meshes of the stencil by means of a squeegee. After stenciling the vitreous enamel metal sheets as above described we may first heat them sufficiently to dry out the oily medium and then heat them in a muffle furnace or otherwise to a temperature sufficiently high to cause fusion of the vitreous enamel background with the vitreous composition applied through the stencil, for example from say about 600° to 1000° C. depending upon the nature of the composition. We thereby obtain real vitreous enamel sheet metal advertising signs or the like.

In carrying out our process particular attention is directed to the cooperative effect between the vitreous paste with oily medium

and the permeable mesh portion of the stencil. In being pressed through the mesh, the vitreous paste is divided up into numerous small particles and so deposited on the enamel base, and remains thus divided to enable the volatile matter to readily pass off. Upon being subjected to heat, all the ingredients of the paste except the vitreous portion, are readily driven off at a temperature below that of the fusion point of the vitreous matter. As a result, when subjected to the fusing temperature, the vitreous particles of the paste are fused into a continuous smooth layer on the enamel base, and are not subjected to the action of volatile matter being driven off. Were the paste to be put on through a cut stencil having ties and without any mesh, it could not be evenly applied, and furthermore, upon being subjected to heat, the volatile matters in the paste could not be so readily driven off since the paste would not be in a finely divided state due to passage through stencil meshes. As a result the finished product would be rough and uneven, due both to the imperfect application, and to the driving off of volatile substances during the fusion of the vitreous material.

By passing the vitreous paste through a mesh stencil, the mesh of the stencil so modifies the condition of the paste as deposited on the base that the stenciled plate can be fired to produce a smooth, even, and highly glazed product.

In producing many designs a cut stencil having ties cannot be employed, but it is necessary to use a mesh stencil. With a mesh stencil, however, dry vitreous material cannot be dusted through the mesh. There was a problem to be solved in getting the ground vitreous enamel through a mesh stencil in a satisfactory manner for design purposes. As pointed out, the vehicle or carrier with which the vitreous enamel is mixed had to be a substance which would enable the vitreous enamel to be readily passed through the mesh and not dry out too rapidly or clog the mesh, because the mesh stencil for practical operation must be used a number of times without having to be cleaned. We found that oils would enable the vitreous enamel to be passed through the mesh without clogging; but the presence of any oil or grease in vitreous enamel has been regarded as fatal to the production of a perfect vitreous enamel surface, because the products of combustion from such oil or grease passing through the enamel, when fused caused blisters or pitting, so much so that in vitreous enamel factories great care has always been exercised in keeping oil or grease from accidentally getting into the vitreous enamel "frit." We further found, however, that if the vitreous enamel composition with oily medium was mixed to a pasty consistency and passed through the mesh, the paste would be applied to the surface in small separated particles as stated, which will not "run" together, thus enabling the volatile matter to pass off freely without blistering the enamel.

We have thus provided a volatilizable pasty medium for the particles of vitreous material and thus made possible the use of a mesh stencil with a vitreous enamel. Further, the action of the mesh of the stencil on the vitreous paste results in depositing the paste on the base in a condition such that heating of the product will drive off the medium portion of the paste and leave only the vitreous particles when the fusing temperature has been reached. Thus the medium portion of the paste permits use of a mesh stencil for vitreous enamel work, and the action of the mesh on the paste permits firing of the product so that very satisfactory results are attained.

The manufacture of vitreous enamel signs consisting of metal plates having a vitreous enamel surface and the lettering or designs impressed thereon by means of vitreous enamel compositions and fused into the enameled surface in accordance with the present invention constitutes an important development in the art and enables vitreous enamel metal signs and the like whether simple or intricate to be manufactured rapidly and relatively cheaply in large numbers. One distinct advantage is in the case of multicolored designs, because each color can be applied and quickly dried ready for the application of the next color, the actual fusing of the colors if they do not overlap being carried out in a single final fusing operation. With some vitreous enamels if it were attempted to fire the article to enamel fusing temperature, after the application of each color of a three of more color design, the enamel would be over fired and deteriorated. According to our process, the stencils last a considerable time before becoming defective through wear and no technical skill or special plant such as is required for lithograph work is necessary in using the stencils.

Vitreous enamel metal signs and the like manufactured in accordance with our invention are as durable as ordinary enamel ware and will withstand rough usage and weather changes for a great length of time without deterioration.

What we claim is:

1. Method of producing designs upon a vitreous surface which comprises taking a pasty vitrefiable enamel composition containing finely ground vitrefiable enamel and an oily carrier and capable of being applied to a surface in subdivided form by being pressed through a fine mesh and of retaining a subdivided form upon said surface until

heated, placing a fine mesh stencil onto the vitreous surface and forcing said composition through the mesh portion of the stencil onto the vitreous surface, whereby the composition will be applied to the design portion of the surface in subdivided form and finally heating the article to an enamel-fusing temperature.

2. Method of producing designs upon a vitreous surface which comprises placing a fine mesh stencil onto the vitreous surface and taking a pasty composition containing a finely ground enamel "frit" and an oily carrier and forcing said composition through the mesh portion of the stencil onto the vitreous surface, whereby the composition will be applied to the design portion of the surface in subdivided form, and finally heating the article to an enamel-fusing temperature.

3. Method of producing multi-colored vitreous enamel designs and other decorative articles which comprises successively applying component parts of a design of different colors to a vitreous enamel surface by successively placing onto the vitreous enamel surface a mesh stencil for each component color of the design, forcing through the mesh portion of each stencil a pasty composition containing finely ground vitreous enamel frit and an oily carrier and of desired color, and between successive applications of such composition to the surface, drying the component of the design thus applied, at a temperature insufficient to fuse the enamel of the composition, and finally heating to an enamel-fusing temperature the article bearing the multi-colored design.

In testimony whereof we have signed our names to this specification.

HERBERT HAMILTON SCOTT.
GEORGE McINTOSH SCOTT.

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BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

EDMUND P. WOOD,
TRUMAN A. HERRON,
Counsel for Respondent.

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BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

History of the Litigation.

This is a conventional suit for patent infringement. No industry questions are involved. No suits of any kind are pending on the same patent against other defendants and none are contemplated. The patent in suit expired almost a year ago and the injunction issued by the District Court long has been dissolved.

All five of the judges who have passed on the Scott patent have arrived at exactly the same conclusions with respect to it. In an earlier suit against another defendant the patent was held valid and infringed by Judge Robert R. Nevin of the United States District Court for the Southern District of Ohio. Judge Nevin rendered a careful and ex-

haustive opinion which is reported in 28 F. Supp. 794. An appeal was taken from this decision but was dismissed shortly before the hearing in the Sixth Circuit Court of Appeals. In the present case Judge Philip L. Sullivan, the trial judge, took the case under advisement and several weeks later rendered the brief oral opinion which is reported in the Record, page 165. The Circuit Court of Appeals for the Seventh Circuit speaking through Judge Sparks rendered an unanimous opinion affirming the decision of Judge Sullivan. This opinion which appears in the Record, pages 206-211 inclusive, has been reported in 129 F. (2d) 803.

With the exception of the case of *Morton Salt Co.* v. *Suppiger*, 314 U. S. 488, which deals with a principle of law which petitioner has never before attempted to apply to the facts of this case and which as we will subsequently show has no application, all of the cases on which petitioner is now relying as a basis for invoking the jurisdiction of this court were carefully considered by the Circuit Court of Appeals. There is no conflict between the decisions of this court relied on by petitioner and the decision of the Seventh Circuit Court of Appeals in the present case.

Nature of Patent in Suit.

The description of the invention of the patent in suit contained in the petition is rather misleading and difficult to follow. For the purpose of clarification we quote the far more accurate and intelligible description contained in the opinion of Judge Sparks (R. p. 207):

> "The process of the patent before us involves generally a series of steps comprising the preparation of a mix of frit (powdered glass), coloring oxide and an oily fluid (called a 'carrier'), forcing the mix through the mesh of a screen stencil

> onto a vitreous surface to be decorated, and then exposing the design and surface to an enamel-fusing temperature. The process provides for the application of a decorative layer of glass to a glass surface so that the design or decorative layer becomes integral with the surface and fully resistant to any form of exposure which can be endured by the surface itself. The equipment necessary to practice the process forms no part of the invention. The screen stencil usually is fashioned from silk or wire mesh having pervious and impervious portions. The impervious outline which forms the design may be placed on the mesh in any one of a number of different ways. The instrumentality used to force the mix through the stencil is usually a rubber scraper called a 'squeegee'."

Claim 2 of the Reissue which is representative, reads:

> "Method of producing designs upon a vitreous surface which comprises placing a fine mesh stencil onto the vitreous surface and taking a pasty composition containing a finely ground enamel 'frit' and an oily carrier and forcing said composition through the mesh portion of the stencil onto the vitreous surface, whereby the composition will be applied to the design portion of the surface in subdivided form, and finally heating the article to an enamel-fusing temperature."

This process is one which has gone into wide and successful commercial use in both the porcelain enamel field and the glass field. As Judge Nevin said, 28 F. Supp. 794 (797):

> "the invention of the Scotts to an appreciable extent revolutionized ceramic decoration. It has in fact virtually created new lines of business, such as the decorated tumblers for the chain store and the decorated food package ware. It has 'advanced the art substantially'."

The Issues Presented by the Petition for Certiorari.

Possibly because of the mark which the Scott patent has made on industry, at no time has the petitioner made any serious effort to question the presence of invention. Only one prior art patent has ever been relied on to negative novelty or invention and that is the Beck et al. patent (R. p. 192) which was fully considered by the Patent Office before the claims of the Scott patent were allowed. It was also considered carefully in both of the reported opinions.

With respect to infringement, generally, it is not seriously questioned but that the defendant's method comes under any ordinary interpretation of the language of the patent claims. The defendant's process was described in interrogatories answered by one of its officers, as follows: (R. p. 4)

> "Powdered ceramic colors containing oxide or coloring material and frit are obtained from the manufacturer in powdered form. In applying this coloring material to the porcelain enamel surface, the powder is mixed with a carrier and then forced through the interstices of a screen by means of a squeegee and is then fused onto the porcelain enamel surface."

If this interrogatory answer is compared with Claim 2 of the patent, quoted on p. 3 herein, it will be noted that prior to trial the infringement issue was narrowed to a point where the defendant denied only that its combined material was "pasty" and that it was applied to the vitreous surface "in subdivided form". These contentions present issues of fact which were found against the defendant by the trial judge after he had witnessed a physical demonstration of the defendant's process and by the Circuit Court of Appeals which had before it specimens of the equipment

and materials used by the petitioner including specimen decorated signs (Exhibits 19 and 32) which clearly show the "subdivided form" called for by the claim.

Accordingly, in its petition to this court the petitioner has been compelled to limit its argument to the three contentions advanced in its petition and brief. These are:

(1) That the Reissue is invalid because it is for a different invention than that called for by the original application,
(2) That there is no infringement because of an enforced file wrapper interpretation of the word "pasty", and
(3) Because of the existence of certain contractual relationships with respect to the patent which are asserted to bar respondent's rights to enforce its patent.

This last issue has never been raised nor even suggested prior to the filing of the petition to this court.

We will reply to each of the petitioner's contentions in order.

The Invention Described In The Reissue Patent Is The Same As That Described In The Application Originally Filed.

The petitioner's contention on this point seems to be that the original application did not specifically state that when the decorating material was forced through the stencil mesh onto the vitreous surface it would be applied in a finely divided condition or "subdivided form". A statement describing this result was added to the application during prosecution of the original patent (R. p. 143-4) and was retained in the reissue. However, the original application, as first filed, clearly describes "working up the powdered quartz-like enamel or 'enamel frit' and oxide

mixture into a suitable pasty mass" (R. p. 133) "and pressing it (the pasty mass) through the meshes of the stencil by means of a squeegee". (R. p. 134)

Original Claim 2 (R. p. 135-6) is representative of the claims as filed. It reads as follows:

> "A method of producing vitreous enamel metal signs and other decorative articles comprising placing a stencil composed of meshed material having permeable and impermeable portions corresponding to the letter or design to be produced upon a vitreous enamel surface, pressing a finely ground vitreous enamel paste through the permeable portions of a stencil and removing the stencil, and finally heating the product to an enamel fusing temperature."

The only difference between this claim and Claim 2 of the reissue patent in suit is that the latter specifies the materials which go to make up the "finely ground vitreous enamel paste" and includes the functional statement that the material is applied to the surface to be decorated "in subdivided form."

Obviously, if the screen stencil is placed on the vitreous surface and a pasty material is forced through the permeable portions of the screen, the resulting design is bound to be applied to the surface in subdivided form because the material is subdivided by the screen mesh. This is all that this language means.

At the trial in the District Court petitioner's witness who conducted the demonstration of its process admitted that during the demonstration the design was "subdivided" by the screen mesh (R. p. 58).

The subdivided form of the design is merely an advantage which is inherent in the process described in the application and claims as originally filed. It is not a new or additional

step in the process. In the whole history of the prosecution of the application and reissue, no amendment that was ever filed changed in any way any single step of the process nor any item of the materials and equipment used in its practice from those specified in the application as first filed. The method steps of Claim 2 of the reissue patent are exactly the same as the method steps of Claim 2 of the application as originally filed.

In the case of *United States Industrial Chemicals, Inc.* v. *Carbide and Carbon Chemicals Corp.*, 315 U. S. 668, which is relied on by the petitioner on this phase of the case, there was a divergence between the original patent and the reissue. The reissue plainly omitted a step in the process which was described and claimed as essential in the original patent. Where the original patent in both specification and claims treated the introduction of water as a necessary step in the process, in the reissue this introduction was made merely permissive. Obviously, this change produced an entirely different invention from that described in the original patent. The reissue involved in the case cited was a very broadening one while in contrast every step in the prosecution of the Scott patent involved in the present case has been narrowing. The original Scott application was narrowed by amendments and the original patent was definitely narrowed by the reissue.

In summary, the reissue of the Scott patent did not omit any of the steps or elements, materials or equipment described in the original patent or even in the original application. The amendments to the original application were simply a recital of an obvious result of the use of the steps of the process as originally described. The reissue simply added material of an explanatory nature which admittedly had the effect of narrowing the scope of the patent.

There Is No File Wrapper Estoppel.

On this point, it seems to be the petitioner's contention that the history of the prosecution of the patent requires a limitation of the meaning of the word "pasty" to a material which is so thick that it will not run together after it has been pressed through the screen. The same argument was vigorously urged before the Circuit Court of Appeals. It is purely a factual argument.

The word "pasty" was used in the original Scott application (R. p. 133) to describe the consistency of the decorating mixture, the ingredients and proportions of which were carefully specified. The word also appeared in original Claims 2, 4 and 5 (R. p. 136-7). It is a word that was voluntarily selected by the inventors; not one the use of which was enforced by the Patent Office. Not a word nor a phrase in the original specification indicated that the Scotts intended to limit themselves to the use of a mix of any exact consistency. By use of the word "pasty" they undoubtedly had in mind a material of a viscosity which would give good results in their process, that is, a material which could be used in cooperation with a screen stencil in such a way that it would not run off the edges of the design after the stencil had been removed and would form, and preferably retain, a corrugated and subdivided surface in the body of the design.

The word "pasty" is an ordinary word in common usage and it accurately describes the consistency of the Scotts material and the petitioner's material as well. Had the inventors or the Patent Office intended some unusual or limited meaning for the word, surely this would have been brought out in the original application or in the claims found allowable. It was established by the evidence that, after it has been mixed, the petitioner's material becomes

progressively thicker and dries out completely within an hour (R. p. 49). Surely the Scott patent cannot be interpreted as covering the use of a material at a given moment but not covering its use ten minutes earlier.

The case of *Schriber-Schroth Company* v. *Cleveland Trust Company*, 305 U. S. 47, relied on by petitioner, is an excellent example of conventional file wrapper estoppel. In that case, the patentee tried to insert into the specification at a late date in the history of the prosecution of the application a statement as to an asserted characteristic of an element in the patented device which was exactly contrary to the characteristics of the element as described in the application as filed. Where the original application described the piston webs as "extremely rigid", the inventor sought by amendment to make them "flexible". It was properly held that the patent could not be stretched to hold as an infringement a structure having flexible webs. However, there is no analogy whatsoever between the facts of the *Schriber-Schroth* case and the facts of the present case. In the present case, the inventors described their preferred material as "pasty" from the beginning of the prosecution of the application to the end. They described the exact ingredients which they used and limited their claims to these ingredients or the equivalents. The petitioner uses close equivalents of the exact materials. In the opinion of every court which has observed petitioner's decorating material, it is "pasty" within the meaning of the inventors and their patent.

There Has Been Nothing Improper In the Licensing of the Scott Patent.

The suggestion, at this late date in the proceedings, that the decision of this court in *Morton Salt Company* v. *Suppiger,* 314 U. S. 488, has some application to the facts of this case illustrates the length to which petitioner has been forced in its attempt to justify its position. The facts are that respondent is the owner of some four or five patents relating to equipment such as screens and tables useful in the practice of the Scott process. These patents are enumerated in Exhibits 39 and 40 but they do not appear in the Record filed with this court. Along with the Scott patent, these equipment patents have been licensed rather widely and on more or less uniform terms to those interested in decorating vitreous surfaces by the Scott process. From the point of view of the public, this type of licensing arrangement has always been considered the most beneficial way of commercializing a patent or a group of patents. There has been no regulation of prices and no improper control of unpatented supplies or materials. There is no evidence whatsoever to support the petitioner's assertion that respondent's licensees are still bound by their contracts even though the Scott patent has expired. Obviously, they are not bound unless they are still using the patented equipment.

The relationship between respondent and Solar Laboratories referred to by petitioner is simply that each company at one time held an exclusive license under the Scott patent but in different fields. The two companies are now and always have been completely separate and distinct. There is not a single common director nor a single common stockholder. The licenses granted by Solar Laboratories which are set forth in the Record pp. 113-127, inclusive, were in-

troduced into evidence by respondent for the purpose of showing the commercial success of the Scott process in the glass field and they were received by the Court for this purpose. Although petitioner does not cite a single reason or authority which has the slightest bearing on the legality of the licenses of Solar Laboratories, the whole matter is completely immaterial because Solar Laboratories is not a party to this case and, except as stated, has no connection of any sort with respondent. Apparently, it is not contended that there is anything improper in respondent's licenses, and petitioner has not even taken the trouble to submit them to this court.

Conclusion.

Summarizing, the respondent submits that there is no issue here involved which in any way justifies the consideration of this case by this court. It is purely a private controversy. The decision has affected and will affect no one but the parties themselves. The issues are almost exclusively factual issues which have been found against petitioner emphatically by the trial court and unanimously by the reviewing court. No unusual or controversial questions of law are involved. The legal issues that are involved have been correctly decided. There is no conflict of any sort between the decision of the Circuit Court of Appeals in this case and the decisions of this court. It is submitted that the petition should be denied.

Respectfully,

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Counsel for Respondent.